

#12/2/2000
3-8-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: MESSERLI *et al.*

Application No.: 09/497,123

Group Art Unit: To Be Assigned

Filed: February 3, 2000

Examiner: To Be Assigned

For: END MEMBER FOR A BONE
FUSION IMPLANT

Attorney Docket No.: 8932-114

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**PETITION FOR RETROACTIVE FOREIGN FILING LICENSE
UNDER 35 U.S.C. §§ 181 AND 184 AND 37 C.F.R. § 5.25**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to 35 U.S.C. §§ 181 and 184 and 37 C.F.R. § 5.25, Applicants hereby request a retroactive foreign filing license for the subject matter of the above-captioned application if such foreign filing license is deemed by the United States Patent and Trademark Office to be necessary. Such a license is sought because the above-captioned application was filed in Taiwan and the Swiss Receiving Office of the PCT with a foreign filing license only having been obtained in a provisional application from which the above-captioned non-provisional patent application claims priority. If a foreign filing license was required under 37 C.F.R. § 5.11 to file such Taiwanese and PCT applications, then the filing of the Taiwanese and PCT applications without having first obtained a new foreign filing license with respect to the above-captioned application was through error and without deceptive intent.

The subject matter of the invention relates to a surgical implant for replacement of bone tissue. It is believed that there is no national interest in maintaining in

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secret the subject matter of the above-captioned application, in particular because a foreign filing license was issued for the parent provisional application for this invention.

It was the understanding of Applicants' attorneys that foreign filing of the above-captioned application was permitted in view of the grant of a foreign filing license on February 26, 1999 in connection with provisional application Serial No. 60/118,806, filed February 4, 1999, ("the provisional application") from which the above-captioned application claims priority under 35 U.S.C. § 119(e). A patent application, based on the above-captioned application therefore was filed in Taiwan on February 2, 2000 (application no. 89101779) and in the Swiss Receiving Office of the PCT on February 3, 2000 (application no. PCT/CH00/00060), without an additional foreign filing license for the additional embodiments that were included in those applications and which were not included in the U.S. provisional application.

If the filing of the Taiwanese and PCT applications required a foreign filing license, the filing of the Taiwanese and PCT applications without first having obtained a foreign filing license occurred through error and was done without deceptive intent. Modifications to the provisional application resulting in the above-captioned application pertain to reconfiguration and relocation of components and do not alter the general nature of the invention in a manner which would require the United States application to have been made available for inspection under 35 U.S.C. § 181. Therefore, it was believed that the modifications to the provisional application resulting in the above-captioned application and the filing of such applications in Taiwan and the Swiss Receiving Office of the PCT were within the scope of the aforementioned granted foreign filing license.

In support of this request, attorneys for Applicants have enclosed the Declaration of Paul D. Bianco, attorney for Applicants. This Declaration includes an explanation of why the material was foreign filed, through error and without deceptive intent,

without the required license under § 5.11 first having been obtained. The Declaration includes: (1) an averment that the portions of the subject matter of the application were not under a secrecy order at the time they were filed abroad, and that the subject matter of the application is not currently under a secrecy order, and (2) a showing that the retroactive license was diligently sought after discovery that a foreign filing license may have been necessary for the filing of the Taiwanese and PCT applications.

The facts and circumstances set forth above establish that the foreign filing of the Taiwanese and PCT applications based on the above-captioned application without a foreign filing license, if required, was made in error and without deceptive intent. Accordingly, this request for a retroactive foreign filing license should be granted if such foreign filing license is deemed to be necessary.

Pursuant to 37 C.F.R. § 1.17(h), Applicants believe that a fee estimated in the amount of \$130.00 is due with this Petition. Please charge the required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,
RODTE 43,500
PAUL D. BIANCO 30,256
Date February 22, 2000
For Allan A. Fanucci (Reg. No.)

PENNIE & EDMONDS LLP
1667 K Street, N.W.
Washington, DC 20006

(202) 496-4400



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

In re: Allan A. Fanucci (Pet.)
Serial Number: 09/497,123
Filed: 3 February 2000
Docket no.: 8932-114

DECISION ON REQUEST
FOR RETROACTIVE LICENSE
UNDER 37 CFR 5.25

Title: End Member for a Bone Fusion Implant

This is a decision on the petition filed 22 February 2000 for retroactive foreign filing license. It has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filing(s) listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought, and that the material was filed abroad without the required license under 37 C.F.R. 5.11 through error and without deceptive intent.

License Approved For:

Country

Taiwan
PCT (Swiss Office)

Date

2 February 2000
3 February 2000

Jeffrey L. Gellner,
Assistant Patent Examiner, Group 3643
(703) 305-0053

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Messerli *et al.*

Application No.: 09/497,123

Group Art Unit: To Be Assigned

Filed: February 3, 2000

Examiner: To Be Assigned

For: END MEMBER FOR A BONE
FUSION IMPLANT

Attorney Docket No.: 8932-114

DECLARATION OF PAUL D. BIANCO UNDER 37 C.F.R. § 5.25 (a)(3)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Paul D. Bianco declare and state:

1. That I am an attorney with the law firm Pennie & Edmonds LLP having offices at 1667 K Street, N.W., Washington, DC 20006; that Pennie & Edmonds LLP represents the inventors and Synthes (USA), the assignee, in connection with the above-identified matter;

2. That the subject matter of the above-captioned application, the End Member for a Bone Fusion Implant, was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order;

3. That the above-captioned application claims priority under 35 U.S.C. § 119(e) from provisional application Serial No. 60/118,806 (hereinafter "the provisional application") and is directed to substantially the same subject matter as the provisional application with some additional disclosure added thereto pertaining to further embodiments,

including the anticipated commercial embodiment, in which certain components of the originally disclosed invention are reconfigured and have been relocated. A foreign filing license was issued in connection with the provisional application on February 26, 1999.

4. Upon information and belief from Mr. P. Kaiser of Dr. Lusuardi AG, Kreuzbühlstrasse 8, 8008 Zurich, SWITZERLAND, attorney for Synthes AG Chur, a related entity to Synthes (U.S.A.), that the above-captioned application was filed in Taiwan on February 2, 2000 without first obtaining a foreign filing license for the above-captioned application, reliance being made on the foreign filing license issued on February 26, 1999 in connection with the provisional application; that the Taiwanese application was assigned application no. 89101779.

5. Upon information and belief from Mr. P. Kaiser of Dr. Lusuardi AG, Kreuzbühlstrasse 8, 8008 Zurich, SWITZERLAND, attorney for Synthes AG Chur, a related entity to Synthes (U.S.A.), that the above-captioned application was filed in the Swiss Receiving Office of the PCT on February 3, 2000 without first obtaining a foreign filing license for the above-captioned application, reliance being made on the foreign filing license issued on February 26, 1999 in connection with the provisional application; that the PCT application was assigned application no. PCT/CH00/00060.

6. That a retroactive foreign filing license has been diligently sought upon discovery that the foreign filing of the End Member for a Bone Fusion Implant may have been proscribed and that the foreign filing license granted on February 26, 1999 in connection with the provisional application may not cover the above-captioned application directed to substantially the same subject matter but not containing an identical specification. Such diligence includes (a) reference to the applicable rules, including 35 U.S.C. § 184, and 37 C.F.R. § 5.25; and (b) the filing of this petition for a retroactive filing license on even date herewith.

7. That the foreign filing in Taiwan and the Swiss Receiving Office of the PCT without first having obtained a foreign filing license under § 5.11 occurred through error and without deceptive intent. It was the understanding of Applicants' attorneys, at the time the above-identified Taiwanese and PCT applications were filed, that the modifications to the provisional application fell under 37 C.F.R. § 5.11(e)(3)(iii) which waives the requirement for a foreign filing license. Although a description of additional embodiments was added, the added embodiments are related to the previously disclosed embodiments except for various modifications as to the configuration and location of certain components of the invention. Accordingly, it was the understanding of Applicants' attorneys that the foreign filing license issued in the provisional application was sufficient for the filing of the Taiwanese and PCT applications because the subject matter of the non-provisional application is substantially similar to that of the provisional application in which a foreign filing license was granted. Upon further consideration, after the filing date of the Taiwanese and PCT applications, it was realized that the addition of subject matter to a U.S. provisional application not previously filed abroad may require a foreign filing license for filing in Taiwan and the Swiss Receiving Office of the PCT as new applications.

8. That a foreign filing license, retroactive to before February 2, 2000 is requested in a Petition enclosed herewith if the U.S. Patent & Trademark Office deems such license to have been required before filing the above-identified Taiwanese and PCT applications.

I hereby declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that I make these statements with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under § 1011 of Title 18 of the United

States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Respectfully submitted,

Date February 22, 2000



43,500

Paul D. Bianco

(Reg. No.)

PENNIE & EDMONDS LLP

1667 K Street, N.W.

Washington, DC 20006

(202) 496-4400

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/497,123	2/22/00	ALLAN A. FANUCCI (PET.)	8932-114

Title: **END MEMBER FOR A BONE FUSION IMPLANT**

Art Unit	Paper Number
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Correspondence Address:

ALLAN A. FANUCCI
PENNIE & EDMONDS
1667 K STREET, N.W.
WASHINGTON, DC 20006

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 524,482

Grant Date: 28-Feb-00

This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.

Approved:

for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application of applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license is granted under 37 CFR 5.15(a)

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]

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